

Appl. No. 09/935,895
Second Supplemental Response after Final Rejection
Reply to Office action of 30 December 2003

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REMARKS / DISCUSSION OF ISSUES

First, regarding the important feature of independent claims 6 and 10 that the filler comprise synthetic resin having a concave surface. This is a critical feature because, as explained in the specification (page 2, lines 13-14), if the resin does not have a concave surface it means that the process has been done incorrectly and the resin may therefore not have good adhesion to the core. Accordingly, this feature cannot be satisfied by a foil and adhesive "sandwich" that appears to form a concave surface according to the opinion of the Examiner -- this feature can only be satisfied by a resin filler having a concave surface. And certainly, even if the Examiner were correct about the foil and adhesive "sandwich" of applicants' figure 3 having a concave shape, and even if the Examiner were correct that there would be motive to combine the Japanese reference teaching by using a resin filler instead of the foil/adhesive, there would certainly be no motivation for anyone to make sure the resin has a concave surface just because of the way the foil/adhesive "sandwich" looks.

Additionally, the Examiner's assertion that the resin filler of Saito et al. (JP 3-241801) would inherently have a concave shape is incorrect because to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added, citations omitted). But since, as applicants' disclosure points out, there are circumstances (e.g., an incorrectly performed curing) that can lead to a non-concave surface, indicating poor adhesion to the core, therefore it cannot be considered inherent under 35 U.S.C. §103(a). Further, Saito et al. do not teach or suggest this feature, showing that it is a novel idea of applicants'. Accordingly, the cited references cannot be combined under 35 U.S.C. §103(a) to produce this feature, and thus the rejection of the claims over these references must be withdrawn.

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Second, applicants respectfully traverse this rejection on the grounds that in maintaining this rejection in a final Office action cites and relies upon an abstract of a non-English document without citation of and reliance upon the underlying scientific document, which is improper, since the record is not clear as to the precise facts the examiner is relying upon in support of the rejection, and whether the examiner is relying upon the abstract or the full text document to support a rejection. **MPEP 706.02.**

Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. See *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished). To determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed. If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. The record must also be clear as to whether the examiner is relying upon the abstract or the full text document to support a rejection. **MPEP 706.02.**

When an examiner makes a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document, the full text document and a translation (if not in English) may be supplied in the next Office action. Making or maintaining such a rejection in a final Office action is inappropriate unless said translation has been supplied. **See MPEP 706.02.**

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

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Respectfully submitted,



Eric M. Bram - Reg. 37,285
Att'y for Applicant(s)
Philips Intellectual Property
& Standards

P.O. Box 3001
Briarcliff Manor, NY 10510-8001
Phone: (914) 333-9635
Fax: (914) 332-06150